

REPLY UNDER 37 CFR 1.116 – EXPEDITED PROCEDURE
TECHNOLOGY CENTER 1700 – GROUP ART UNIT 1714
MAIL STOP AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF: MITCHELL M. JACKSON ET AL.

DOCKET No.: 3151 B/R-01 CUSTOMER NUMBER: 26645

SERIAL No.: 10/511,003 EXAMINER: CEPHIA D. TOOMER

FILED: OCTOBER 12, 2004 GROUP ART UNIT: 1714

TITLE: METHOD OF OPERATING INTERNAL COMBUSTION ENGINE BY INTRODUCING ANTIOXIDANT INTO COMBUSTION CHAMBER

Mail Stop AF
Hon. Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Wickliffe, Ohio
Dated: August 17, 2007

Sir:

RESPONSE AND REQUEST FOR RECONSIDERATION

This is in response to the office action dated July 13, 2007, to which a response is due by September 13, 2007. Please review the above identified application in view of the following remarks.

I hereby certify that this correspondence is being filed electronically via the USPTO EFS with the Commissioner for Patents, United States Patent & Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 on:

Date of Deposit

8/21/07

Deposited by: Nancy S. Dedek

Nancy S. Dedek

Response

This application is a national stage application under 35 U.S.C. §371 which claims priority from PCT/US03/11249, and US Provisional Application No. 60/374,640, filed on April 23, 2002 per §119(e). The priority date of the present application is thus April 23, 2002.

The Examiner rejected claims 1 and 4-10 under 35 U.S.C. 103(a) as being unpatentable over Mobil (WO 94/22988) in view of Kanakkanatt (US 6165234) and Moreton (US 2004/0186027). The Examiner also used this set of references in combination with other references to reject all other pending claims in the application.

Moreton (US 2004/0186027) was filed on February 19, 2004 and published on September 23, 2004. It is believed that the earliest foreign equivalent of Moreton to have been published is WO 03/018728, which was published on March 6, 2003. Moreton was filed as provisional application No. 60/314,825 on August 24, 2001. These publication dates for Moreton are all after the April 23, 2002 priority date of the present application.

In light of the above, Moreton qualifies under §102(e) as prior art against the present application but not under any other section of §102.

I, the undersigned, an attorney of record, hereby state that the present invention and the above identified reference, Moreton (US 2004/0186027), were owned by or subject to assignment to the same person at the time the present invention was made. In particular, the application and Moreton are and were assigned to The Lubrizol Corporation. Pursuant to 35 U.S.C. §103(c)(1), this common ownership precludes a rejection under 35 U.S.C. §103(a) based on §102(e). Therefore, Applicants respectfully request that all rejections based on this references be removed and all claims be allowed.

The Examiner also rejected claims 12 and 15 under 35 U.S.C. 103(a) as being unpatentable over Mobil (WO 94/22988) in view of Kanakkanatt (US 6165234) and Moreton (US 2004/0186027) and further in view of Foster (US 6904752) and Arrowsmith (US 2004/0077506).

Applicants have already shown that Moreton is not an available reference against the present application. For completeness it is noted that Arrowsmith (US 2004/0077506) was filed on October 22, 2002 and published on April 22, 2004. These dates are all later than the present priority date. Therefore Arrowsmith is not a proper reference against the present application under any section of 35 U.S.C. §102. Applicants respectfully request that all rejections based on Arrowsmith be removed and claims 12 and 15 be allowed.

Applicants have shown that Moreton and Arrowsmith are not proper references against the present application. As all rejections of the claims in the present application are based on at least one of these references, Applicants respectfully ask that all rejections be removed.

Conclusion

For the foregoing reasons it is submitted that the present claims are novel, unobvious and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "David M. Shold". The signature is fluid and cursive, with the first name "David" and last name "Shold" clearly distinguishable.

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